

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte R. BRENT WILLIAMS, KENNETH L. WHITE
and GREGORY L. CLARK

Appeal No. 2004-1666
Application No. 09/586,912

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3 and 6-11, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a sealant for sealing around conduits (claims 1-3) and to methods of sealing around conduits (claims 6-11). An understanding of the invention can be derived from a reading of exemplary claims 1 and 6, which appear in the appendix to the appellants' Brief.

The prior art relied upon by the examiner in rejecting the appealed claims is:

Grannis III (Grannis)	3,841,032	Oct. 15, 1974
Isgur <u>et al.</u> (Isgur)	4,182,649	Jan. 8, 1980

The prior art insecticides disclosed on page 4 of the appellants' specification (the admitted prior art).

Claims 1-3 and 6-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grannis in view of Isgur and the admitted prior art.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 28) and the final rejection (Paper No. 21) for the examiner's reasoning in support of the rejection, and to the Brief (Paper No. 26) and Reply Brief (Paper No. 29) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The appellants' invention deals with the problem of insect infestation in pad mounted electrical transformers and the like, wherein the insects gain entry to the housing through the opening provided for conduits. As manifested in independent claim 1, the invention comprises, inter alia, a flexible foam sealing material which expands in its unset state and is flexible in its final set state and an insecticide dispersed in the flexible foam sealing material for killing insects attempting to enter the housing, wherein the set foam substantially seals around the conduits extending through the opening into the housing as well as around the perimeter of the opening. The housing is selected from the group consisting of secondary pedestal boxes of street lights, secondary distribution pedestal boxes, telecommunications junction cabinets and pedestals, and electrical distribution pad mounted switches and circuit breakers. The insecticide is selected from the group consisting of acephate, carbaryl, pyrenone, aldicarb and azonphos-methyl.

The examiner has rejected this claim as being obvious¹ in view of the combined teachings of Grannis, Isgur and the admitted prior art. In arriving at this conclusion, the examiner has found all of the subject matter recited in the claim to be disclosed or taught by Grannis, except for the particular pedestal boxes and the type of sealant specified. As to the first of the missing limitations, it is the examiner's view that the switchgear recited by Grannis "would encompass" those named in the claim. With regard to the sealant, the examiner takes the position that it would have been obvious to modify the Grannis system by replacing the disclosed sealing means with a sealant of the type disclosed by Isgur "since merely the substitution of one plastic part for another is contemplated," and to utilize the specified types of insecticides since, as evidenced by the admitted prior art, they were known at the time of the appellants' invention and solve no stated problem. See Paper No. 21, pages 3 and 4. We do not agree, on the basis of the reasoning that follows.

¹The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness under 35 U.S.C. §103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Grannis discloses a load-bearing pad for supporting items such as transformers, switchgear and air conditioning units in a housing 12. As shown in Figure 2, a cableway 70 is provided in the pad, through which cables 72 pass from beneath the surface of the ground into housing 12, and an "appropriate filler material 94" is disposed in the opening "to prevent rodents and other small animals from entering" the housing (column 5, lines 24-27). The filler material is disclosed as being "a mixture of epoxy resin and soil particles, the latter contributing a certain degree of brittleness or breakability to the filler material" so that "the cured filler material 94 may be broken and removed from the cableway 70 without difficulty if such action is ever necessary in order to service cables 72 or remove the installed unit" (column 5, lines 28-35). There is no stated concern in Grannis for the problem of insects entering the housing or for placing any chemical additive in the filler material, much less an insecticide.

Isgur discloses a composite sheet useful for such end products as drapery backing, upholstery backing, blankets, absorptive padding, wall coverings, acoustical panels, and other protective surfaces such as apparel and shoe linings (column 6, lines 34-44). The sheet comprises particles of polyurethane foam and fibers intertwined with the foam and binding the mixture together. The sheet is compressible and resilient, but there is no teaching that it is suitable for being positioned in an opening to seal around objects extending therethrough. Isgur does, however, teach that insecticides may be combined into the sheet (column 6, lines 9-14).

As for the insecticides named in the claim, the fact that they are among those that were known in the art at the time of the appellants' invention would not, in our opinion, in and of itself have suggested to one of ordinary skill in the art that these particular ones be placed in a foamed sealing material used to close the opening in the base of an above ground electrical housing through which conduits extend.

The mere fact that the prior art could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in any of the references which would have led one of ordinary skill in the art to replace the filler material of Grannis with a material manufactured in accordance with the teachings of Isgur, and to add thereto the particular insecticides recited in the claim. We first note, in this regard, that Grannis teaches that the filler material be brittle so that it can be "broken" if necessary to be removed and, no doubt, so that the rodents and small animals about which Grannis is concerned cannot penetrate it with their teeth and claws. Thus, from our perspective, one of ordinary skill in the art would not have been motivated to remove the brittle seal and replace it with a flexible one, as the examiner has proposed, for to do so would provide a seal that would appear to be incapable of performing the task of preventing the entry of rodents and small animals, which is an object of the Grannis invention. Second, there is no recognition in either reference of the problem of insects gaining

entrance into a housing for electrical equipment or of the need to include an insecticide in the ingredients of the seal, or that there is an advantage to utilizing a seal that is flexible in its final set state. Third, Isgur discloses a sheet material usable for reinforcing fabrics and the like, and does not suggest that it can be utilized in such a fashion as to seal around the perimeter of an opening in a housing and around the conduits extending through the opening, nor does it appear that it is capable of doing so. Fourth, absent the teachings found in the appellants' specification, there is no suggestion that the recited adhesives be mixed into the sealant.

For these reasons, it is our conclusion that the combined teachings of Grannis, Isgur and the admitted prior art fail to establish a prima facie case of obviousness with respect to the subject matter recited in claim 1, and we therefore will not sustain the rejection of claim 1 or, it follows, of claims 2 and 3, which depend from claim 1.

Independent claims 6, 8, 10 and 11 are directed to methods of sealing around conduits. Each method includes utilizing a sealant that is flexible in its final form, as well as incorporating a quantity of contact poison insecticide in the sealant material. With regard to the rejections of these claims, we initially note that the examiner has failed to explain where any of the claimed steps are taught by the references, and how the references would be combined in order to render the claimed methods obvious. Lacking such specificity, the applied references fail to establish a prima facie case of obviousness with respect to the subject matter of the method claims, and we will not

sustain the standing rejection against them. In addition, the reasoning set forth above with regard to claim 1 also is applicable for, as was the case there, it would appear that suggestion to combine the references in the manner proposed by the examiner is found only in the hindsight afforded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection under Section 103.²

The rejection of claims 6-11 is not sustained.

CONCLUSION

²In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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